

REMARKS

Claims 1, 6 and 17 stand objected to for certain informalities. Applicant has amended claims 1 and 6 to correct the informalities. Claim 17 has been cancelled. Reconsideration and withdrawal of the objection to claims 1, 6 and 17 is respectfully requested.

Additionally, Applicant has cancelled claims 15 and 16.

Rejections under 35 U.S.C. § 112

Claims 1-6, 11 and 13-17 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Specifically claim 1 is rejected for claiming an amount of “50%” for both (A) and (B). Applicant has amended claim 1 to reflect that the amount of (A) is between 10% and less than 50% and the amount of (B) is between greater than 50% and 90%. The Examiner has stated that there is support for the amended recitals (Final Office Action, pg. 4, lines 1-2).

Furthermore, claim 1 is rejected for claiming an amount of ground rubber of between greater than 0 and 5 percent by weight. The Examiner states that the specification only includes support for “up to 5 percent, which includes 0 percent.” (Final Office Action, p. 4, lines 1-5).

It is not necessary for the claimed subject matter to be described literally or “*in ipsius verbis*” in order for the specification to satisfy the description requirement. *In re Lukach*, 442 F.2d 967, 969, 169 U.S.P.Q. 795,796 (C.C.P.A. 1971). Furthermore, it is sufficient that the specification convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). The PTO always has the burden of demonstrating that the applicant has failed to comply with the written description requirement. *In re Edwards*, 568 F.2d 1349, 1356, 196 U.S.P.Q. 465, 469 (C.C.P.A. 1978). As the MPEP states:

With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. MPEP § 2163.05 (I).

Applicant respectfully asserts that the statement in the specification that the amount of crumb rubber may be up to 5%, coupled with the example and statements in the specification of the type of crumb rubber to be used and the amount of crumb rubber used in the example, indicating an amount greater than 0, is information sufficient to clearly convey to those skilled in the art that Applicant had invented the specific subject matter as claimed, *i.e.*, an amount of ground rubber of from greater than 0 to 5%.

Additionally, regarding claim 15, the Examiner stated that the specification lacked support for the limitation of claim 15: "wherein the ground rubber is not subjected to a surface activation treatment." (Final Office Action, p. 4, line 5). Applicant has cancelled claim 15.

Rejections under 35 U.S.C § 103(a).

Claim 1-3, 5-6, 11, and 13-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP Patent Application 0 102 844 of Polysar Limited in view of U.S. Patent No. 4,064,922 of Farber, *et al* and U.S. Patent No. 3,860,539 of Miyazato.

{The Examiner also mentions [on page 6 of the Final Office Action, lines 6-12] U.S. Patent 3,769,122 of Coddington et al as applied to the cement and method claim 16}.

Before specifically responding to the rejections made above by the Examiner under 103(a), the applicant would like to point out some features of his claimed invention, as now amended.

The applicant has amended claim 1 to recite that the "puncture sealing composition" is non-aqueous. This is not new matter. It is clear from the specification as filed that the composition does not use a Latex, does not use an aqueous Emulsion, or does not add Water to the composition.

Claim 1 has also been amended to recite the proper amounts of the "low molecular weight liquid rubber" and the "high molecular weight solid elastomer". As mentioned above, the Examiner stated that the applicant has support for the recited amounts. However, applicant further points out that the "liquid rubber" is used in a minor proportion (less than 50% by

weight), and the “solid elastomer” is used in a major proportion (greater than 50% by weight), both based on the combined weights of the two components.

Lastly, applicant clearly shows in the Example that the use of the Ground Rubber in the sealant composition results in better air retention when the tire is subjected to a puncture. The benefit of using the ground rubber in the sealant composition is demonstrated.

As to the specific rejections made by the Examiner under 103(a):

EP844 discloses a tire having puncture-sealing characteristics, the tire comprising as the inner liner an irradiated laminate (EP844, p.1, lines 2-5). EP844 discloses that the essence of its invention is this laminate,

the inner layer of which is a puncture-sealing laminate, the inner layer of which is a polymer degraded by irradiation, such that when both the inner liner is penetrated by a puncture means and when the puncturing means is removed, sealing of the inner liner will occur at the point of puncture, such sealing being by the degraded polymer of the inner liner of the laminate. EP844, p. 5, lines 15-25.

Applicant's invention does not disclose or teach the use of an irradiated laminate.

In rejecting the applicant's claims, the Examiner states what the primary reference EP844 does not disclose (Final Office Action, pg. 5, lines 1-6). So, the Examiner combines the other cited references to find the missing disclosure.

As to the Farber reference ('922), the patent discloses a puncture sealing composition in which the low molecular weight elastomer is present in a major amount of the composition, more than 50% by weight ('922, col. 4, lines 14-19). The '922 reference does not disclose or teach the use of Ground Rubber.

Applicant claims a tire having, *inter alia*, a puncture-sealant composition covering an interior surface of the tire, where the puncture sealing composition comprises a minor amount of

the low molecular weight liquid rubber, and the use of greater than 0 to 5% by weight of Ground Rubber (claim 1).

As to the Miyazato reference ('539), the patent discloses a tire lining agent which is comprised of an aqueous dispersion having (1) an adhesive "consisting essentially of" an aqueous emulsion of specifically recited polymers, which polymers are chosen to be adhesive to rubber and dispersible in water, where 100 parts of the emulsion contains 18 to 54 parts of water, and (2) particulate solid rubber particles which are intimately dispersed in the aqueous dispersion (see Summary of the Invention, Para. 1). The rubber particles are used only in an aqueous dispersion having a very low viscosity (230-1350 cps at 21 degrees C.). The reference teaches that, in using the agent to line a tire, a portion of the water remains in the lining agent inside of the tire (see Detailed Description, Para. 9).

In applicant's composition, the ground rubber is mixed together with the liquid rubber and the solid elastomer. The claimed invention does not disperse the ground rubber in an aqueous dispersion; and the invention does not use the rubbers or elastomers in an aqueous emulsion, and does not have water in the composition.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented for the claims, as amended. Specifically, EP844 does not disclose the amounts of the liquid rubber and the solid elastomer that are used, and does not disclose the use of ground rubber. Farber '922 teaches away from the claims being examined because Farber teaches that the high molecular weight elastomer must be in a minor amount of the sealant. Also, '922 does not teach the use of ground rubber in the composition. Lastly, although Miyazato '539 shows the use of a particulate rubber, '539 is directed to and discloses aqueous dispersions wherein the elastomer is present as an aqueous emulsion, and the particulate rubber is dispersed therein.

As to Coddington '122, the reference discloses a liner of a halo/butyl rubber dissolved in an organic solvent to form a cement. Specific amounts of a liquid rubber and a solid elastomer are not disclosed, and the use of ground rubber is not disclosed. So, '122 does not add to the cited references to supply the missing disclosure. Further, claim 17, which was directed to a method of applying the applicant's composition in the form of a cement, has been cancelled.

Therefore, because the prior art references fail to disclose each and every limitation of applicant's amended claims, applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-6, 11, 13-14 and 16.

Applicant respectfully asserts that all claims are now in condition for allowance and requests the timely issuance of the Notice of Allowance. If the Examiner believes that a telephone interview would expedite the examination of this pending patent application, the Examiner is invited to telephone the below signed attorney at the convenience of the Examiner. In the event there are any fees or charges associated with the filing of these documents, the Commissioner is authorized to charge Deposit Account No. 13-3085 for any necessary amount.

Respectfully submitted,

MICHELIN NORTH AMERICA, INC.

A handwritten signature in black ink, appearing to read "Alan A. Csontos". The signature is fluid and cursive, with the first name "Alan" and last name "Csontos" clearly distinguishable.

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